

REMARKS

Claims 1, 5, 6, 16, 19, 20, 23, 29, 31-33, 35, 42, 44, and 45 have been amended. Claims 4, 18, 30, and 43 have been cancelled. No claims have been added. Therefore, claims 1-3, 5, 7-15, 17, 21, 22, 24-28, 34, 36-41, and 46-48 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks.

Double Patenting Rejection:

The Examiner rejected claims 1-48 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of Application No. 10/091,203. For at least the reasons below, Applicants respectfully request removal of the double patenting rejection of claims 1-48.

The Examiner rejected claims 1-48 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 21-26, 28-35, 37-38 of Application No. 10/090,893. For at least the reasons below, Applicants respectfully request removal of the double patenting rejection of claims 1-48.

Applicants recognize that the provisional nonstatutory double patenting rejections are based on *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968), as covered in MPEP 804.II.B.2. Applicants note that MPEP 804.II.B.2 states that nonstatutory double patenting rejections based on *Schneller* **will be rare**.

In particular, Applicants reference the third paragraph of MPEP 804.II.B.2:

The decision in *In re Schneller* **did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision**. The court in *Schneller* cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." *Schneller*, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any

nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made. (emphasis added)

First, Applicants note that the MPEP clearly emphasizes again that nonstatutory double patenting rejections based on *Schneller* **will be rare** and are **limited to the particular set of facts set forth in that decision**. Applicants further note that the supervisory patent examiner (SPE) must agree with a double patenting rejection based on *Schneller*, and the Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. Examiner Note 1 for form paragraph ¶ 8.39 states that:

This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.

Thus, since “nonstatutory double patenting rejections based on *Schneller* **will be rare**”, and approval of both the SPE and TC Director are required before a nonstatutory double patenting rejection based on *Schneller* can be made, **Applicants respectfully request formal indication that both the SPE and the TC Director have approved of the nonstatutory double patenting rejections based on *Schneller* as is required by the MPEP.**

Section 103(a) Rejections:

The Examiner rejected claims 1-48 under 35 U.S.C. § 103(a) as being unpatentable over Mansour et al. (U.S. Publication 2002/0111995) (hereinafter “Mansour”) in view of Dutta et al. (U.S. Patent 6,615,212) (hereinafter “Dutta”). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, contrary to the Examiner's assertion, Mansour in view of Dutta fails to teach or suggest that **the server is further configured to plug a converter module into a framework configured to accept one or more pluggable modules, wherein the converter module is configured to generate a document in a small device format from one of the documents in one of the one or more server formats.** The Examiner admits that Mansour fails to disclose this feature of claim 1, and relies on Dutta for this teaching; however, Applicants assert that Dutta also fails to suggest the pluggable converter module recited in the claims. With regard to this feature, the Examiner states, "Dutta discloses the transcoding proxy server including a transcoding framework having transform plugin (Fig. 6) or transcoder plugin (Fig. 7)". Applicants note that the transform plugin is mentioned only once in the entire specification Dutta (column 7, lines 50-53). More specifically, this portion discloses that the "transcoding framework 608 includes HTTP request transform plugin 610 for converting HTTP request 604 received from client 602 into a modified HTTP request 612 compatible with originating server 614, where the requested content is located". Applicants assert that the transform plugin 610 is not configured to generate a document in a small device format from one of the documents in one of the one or more server formats as recited in the claims. Instead, the transform plugin of Dutta converts a HTTP request from the client to a modified HTTP request compatible with the server. Conversion of a HTTP request is not generation of a document in a small device format from one of the documents in one of the one or more server formats. One skilled in the art understands that requests are not documents. Thus, even if the teaching of Dutta were combined with those of Mansour, such a combination would clearly not result in Applicants' claimed invention.

Additionally, the transcoder plugin cited by the Examiner also fails to teach the converter module recited in the claims. Applicant notes that the transcoder plugin is also mentioned only once (column 7, lines 58-62) in the entire specification of Dutta. This portion recites "transcoding framework 608 also includes XML to HTML transcoder plugin 704. XML to HTML transcoder plugin 704 converts server response 702 from XML data format to an HTML data format and sends HTML data 706 to client 602 for processing". Thus, the transcoder plugin may convert a response to the HTTP request

sent by the client back into a HTML format. In other words, the transcoder plugin and the transform plugin operate to convert requests and responses between the client and the server, e.g., from XML to HTML and vice versa. Clearly, the requests and responses that are converted by the plugins in Dutta are not the generated documents in small device formats recited in the claims.

Additionally, the Examiner asserts, “the converter module (Dutta, the transcoder plugin) is configured to generate a document in a small device format (Dutta, client formats or PDF or HTML documents) from one of the documents in one of the one server format(s) (Dutta, postscript documents)” [sic]. **As noted above, contrary to the Examiner’s assertion, Dutta nowhere teaches that the transcoder plugin is configured to generate documents in a small device format;** instead, Dutta teaches that requests may be converted from HTML to HTML or from XML to HTML. Dutta nowhere mentions, suggests, *or even hints at* the transcoder plugin converting to or from postscript formats or converting documents at all. Clearly, the Examiner has mischaracterized the teachings of Dutta; Dutta nowhere teaches or suggests the converter module recited in the claims. Furthermore, Applicants assert that Dutta nowhere teaches that the server is operable to plug the transform plugin or the transcoder plugin into a framework; instead, Dutta discloses that the transcoding framework already includes the transform and transcoder plugins. Thus, Mansour in view of Dutta fails to teach or suggest that *the server is further configured to plug a converter module into a framework configured to accept one or more pluggable modules, wherein the converter module is configured to generate a document in a small device format from one of the documents in one of the one or more server formats.*

In the instant Office Action, the Examiner responds by asserting:

Examiner points out the prior art taught that, “the server sends form to client device (i.e., PDA) in a suitable format” (Mansour, [0161]). “The server 402 transcodes the document format provided by servers 412, 414, 416 to client formats and sends them to clients 404, 406, 408, 410” (Dutta, Fig. 4, column 6, lines 16-46)

Applicant notes that the Examiner previously admitted that Mansour failed to teach this element of claim 1, and relied on Dutta to teach the feature (as argued above). However, Applicant notes that the Examiner cites paragraph [0161] of Mansour which fails to teach, suggest, *or even hint at* a converter module, much less one configured to generate a document in a small device format from one of the documents in one of the one or more server formats as recited in claim 1. Thus, Applicant asserts that the Examiner's arguments fail to provide a *prima facie* case of obviousness.

As also argued above, the transcoder plugin of Dutta does not perform transcoding of document formats, instead the transcoder plugin of Dutta converts **requests** (not generating small device formatted documents as required by claim 1) between HTML or XML formats. The Examiner seemingly ignores these arguments and cites a different portion of Dutta, which does not relate to the plugin previously cited, where the transcoding server (not plugin) performs some type of document translation. Clearly, as one skilled in the art understands, the server is not a converter module in a framework for pluggable modules configured to generate a document in a small device format from one of the documents in one of the one or more server formats as recited in claim 1. Thus, Applicants reassert that the Mansour and Dutta, taken singly, or in combination, fails to teach this limitation of claim 1.

Additionally, Applicants submit that Mansour and Dutta fail to teach or suggest that the converter module is further configured to receive a modified version of the document in the small device format from the small device, and generate a modified version of the document in the server format from the modified version of the document in the small device format. More specifically, as argued above, the transcoder plugin of Dutta converts requests and not documents as required by this limitation of claim 1. Neither Dutta, nor Mansour, taken singly, or in combination, teach a converter plugin configured to perform the reception and generation of the limitation recited above.

With further regard to claim 1, Applicants submit that the provided motivations to combine the Mansour and Dutta references are improper. More specifically, the Examiner provided the following motivations from Mansour and Dutta:

for the purposes of making the display of the application data much more appropriate for the client device (Mansour, paragraph [0022]) or minimizing transmission times (Dutta, col. 2, lines 26-36).

Applicants assert that the provided motivations do not relate to the proposed combination. For example, in Mansour, “making the display of the application much more appropriate for the client device” refers the benefits provided by the UI structured provided by Mansour. There is no need whatsoever to include the transcoder plugin of Dutta to achieve this presumed benefit. Additionally, as argued above, the transcoder plugin of Dutta is directed towards conversion of requests and responses between the server and the client. Clearly, Mansour is capable of handling communication between the server and client without this plugin; Mansour nowhere indicates the desirability of this feature. The motivation cited in Dutta “minimizing transmission times”, which relates to the speed at which data may be transcoded, does not imply or suggest any reason to make the specification combination proposed by the Examiner. Instead, this minimization of transmission times indicates the presumed benefits of using the invention disclosed by Dutta. Applicants remind the Examiner that, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant notes that in the Response to Arguments section, the Examiner asserts:

Examiner points out the prior art clearly disclosed that Dutta's teachings of transcoding servers with Mansour's teachings of documents in server formats and small device formats, for the purpose of enabling communications with different document formats among the network devices (Dutta, col. 2, lines 22-25).

Applicants assert that the Examiner has again failed to provide a proper motivation to combine Mansour and Dutta. The Examiner has only provided reasons which indicate the presumed benefit of the transcoding server used in Dutta. The cited portion nowhere indicates the specific combination of Mansour's teaching and Dutta's transcoding server. Applicant further asserts that Mansour does not require the document conversion of Dutta since Mansour already provides a method for providing information to the small device (i.e., of various formats, by using UI forms). Thus, the transcoding server of Dutta is not required or beneficial to Mansour. Applicants also note that Dutta's transcoding server (cited by the Examiner as part of the motivation to combine) is not the transcoding plugin that the Examiner cites as the pluggable module. As argued above, the transcoder plugin of Dutta is directed towards conversion of requests and responses between the server and the client. Thus, the provided motivation does not address the specific combination proposed by the Examiner. Additionally, Mansour is clearly capable of handling communication between the server and client without this plugin, and furthermore, Mansour nowhere indicates the desirability of this feature. For at least the reasons above, Applicants assert that the Examiner has failed to provide a proper suggestion to combine the two references Mansour and Dutta. Additionally, even were the two references properly combinable, which Applicants argue they are not, they would still fail to teach or suggest the invention as claimed. For at least the reasons above, the rejection of claim 1, and those claims dependent therefrom, is not supported by the cited art and removal thereof is respectfully requested.

With regard to claim 3, Mansour in view of Dutta fails to disclose **wherein the converter module is further configured to exclude one or more format features of the document in the server format from the document in the small device format**. Regarding this claim, the Examiner cites column 6, lines 1-15, and asserts:

Dutta, the transcoding server receives the information including the data formats acceptable by the client device, translates the client content formats to a format compatible with the particular server where the content is located.

Clearly, this is irrelevant with respect to the recited feature of claim 3 above. Nowhere in this paragraph, nor anywhere else, does Dutta teach exclusion of format features of the document as recited in claim 3.

With further regard to claim 3, the cited portions of Dutta (as well as any other portion of Dutta) fails to teach or suggest the pluggable converter module excluding format features of the document. Instead, the cited portions of Dutta teach the method by which the server and client communicate information and documents. There is no mention of the exclusion of format features, as recited in the claims, by Dutta. Applicants assert that the Examiner has clearly mistaken document formats with format features of documents.

For at least the reasons above, the rejection of claim 3, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested. Independent claims 16, 29, and 42 include similar limitations as claim 1, and so the above arguments apply with equal force to claims 16, 29, and 42. Furthermore, as shown above in regard to claim 3, the cited art does not disclose excluding one or more format features of the office document from the small device document. Thus, for at least the reasons provided above, the rejection of claims 16, 29, and 42, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested.

The Examiner rejected claims 1-48 under 35 U.S.C. § 103(a) as being obvious over Mansour et al. (U.S. Publication 2002/0111995) (hereinafter “Mansour”) in view of Dutta et al. (U.S. Patent 6,615,212) (hereinafter “Dutta”) and Sahota et al. (U.S.

Publication 2001/0056460) (hereinafter “Sahota”). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, the cited art fails to teach or suggest **wherein the converter module is further configured to receive a modified version of the document in the small device format from the small device, and generate a modified version of the document in the server format from the modified version of the document in the small device format.** Applicants note that the Examiner cites various portions of Mansour for this portion of claim 1; however, this limitation is specifically relates to the converter module, which the Examiner admits Mansour fails to disclose. Thus, Applicants assert Mansour cannot teach these features. However, Applicants note that the Examiner cites paragraph [0118] of Mansour for “receiving a modified version of the document in the small device format from the small device”. The cited paragraph actually only describes that the client application (which receives the various UIs from the server) may “reside on a client device” and “is preferably configured in a manner that isolates the platform-specific and/or OS-dependent code”. Applicants assert that this has nothing to do with the recited limitation. With respect to “generating a modified version of the document in the server format from the modified version of the document in the small device”, the Examiner cites paragraphs [0067]-[0135], [0153]-[0167], [0185]-[0218]. Applicants note that this is an extremely large portion of Mansour. As has already been brought up numerous times in this prosecution history, Applicant reminds the Examiner that, according to the MPEP 706, “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity”. Additionally, 37 CFR 1.104 states:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicant therefore requests that the Examiner more particularly point out which section of Mansour teaches this feature of claim 1 and provide a clear explanation of the rejection.

In general, Mansour describes that modifications made on the client device is stored in a “shadow cache” (see paragraph [0096]). The UI server is able to monitor the “shadow cache” to update the document being modified. Applicants assert that this monitoring and updating process fails to teach or suggest receiving a modified version of the document in the small device format from the small device, and generating a modified version of the document in the server format from the modified version of the document in the small device format. Instead, in Mansour, changes made by the user are monitored and used for updating. As one skilled in the art understands, this process is not the same as receiving a document in one format and generating another version of the document from the received document.

With further regard to claim 1, Applicants submit that the provided motivations to combine the Mansour and Dutta references are improper. The Examiner asserts:

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Sahota’s teachings of HTML converter 208 is designed to be extended using a plug in architecture for adding on new conversion modules (Sahota, [0060]) with the teachings of Mansour, for the *purpose of displaying on multiple types of platforms or formats e.g., HTML, portable document format, Postscript, or other like formats* (Sahota, [0034]).

Similar to above, Applicants assert that the provided motivation only describes a presumed benefit of Sahota without pointing out any particular reasons why the specific combination should be made. As the Examiner is certainly aware, the showing of a suggestion, teaching, or motivation to combine prior teachings **“must be clear and particular. The art must fairly teach or suggest to one to make the specific combination as claimed.”** Applicants further assert that the pluggable architecture taught by Sahota is not necessary or beneficial to the system of Mansour. Mansour already describes a method for displaying application content on small devices through the use of UI forms. In contrast, the teachings of Sahota relate to tag and layout modification of HTML documents. Thus, similar to above, Mansour does not require the teachings of Sahota to display various documents “on multiple types of platforms” as

asserted by the Examiner. As one skilled in the art would understand, there is no reason, other than the Applicants' current disclosure, to perform the specific combination suggested by the Examiner. Additionally, even were they combinable (which Applicants argue they are not), the cited references still fail to teach all the limitations of claim 1.

For at least the reasons above, the rejection of claim 1, and those claims dependent therefrom, is not supported by the cited art and removal thereof is respectfully requested. Independent claims 16, 29, and 42 include similar limitations as claim 1, and so the above arguments apply with equal force to claims 16, 29, and 42. Furthermore, as shown above in regard to claim 3, the cited art does not disclose excluding one or more format features of the office document from the small device document. Thus, for at least the reasons provided above, the rejection of claims 16, 29, and 42, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested.

Section 102(e) Rejection:

The Examiner rejected claims 1-48 under 35 U.S.C. § 102(e) as being anticipated by Sahota. Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, Sahota fails to disclose **wherein the converter module is further configured to receive a modified version of the document in the small device format from the small device, and generate a modified version of the document in the server format from the modified version of the document in the small device format**. With regard to this feature, the Examiner cites paragraph [0054] for “receiving the modified version”, and paragraphs [0054]-[0056], [0062], [0092], and [0093] for “generating a modified version”. Paragraph [0054] actually discloses a repository that stores rules for capturing, versioning, cataloguing, indexing, and querying as well as conversion rules for content delivery to a variety of execution environments. Applicants

assert that a repository which may be used by the set top box to provide data from a server to a TV fails to teach or suggest the converter module being configured to receive a modified version of the document in the small device format. The simple fact that a repository exists in no way teaches or suggests this limitation of claim 1. As the Examiner is certainly aware, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The remaining paragraphs further describe how the data may be converted by the set top box for display on the TV. Applicants assert that this one way conversion in no way teaches, suggests, *or even hints at* the specific reception and generation recited in claim 1. None of the cited paragraphs (or any of Sahota) teach this feature of claim 1. Applicants note that paragraph [0092] relates to a web page content authoring tool that allows the user to customize various “looks and feels” of webpages. However, Applicants assert that customizing templates that are used to modify incoming HTML/XML documents do not relate to the specific reception and generation process recited in claim 1. Thus, Sahota fails to teach this feature of claim 1.

For at least the reasons above, the rejection of claim 1, and those claims dependent therefrom, is not supported by the cited art and removal thereof is respectfully requested. Independent claims 16, 29, and 42 include similar limitations as claim 1, and so the above arguments apply with equal force to claims 16, 29, and 42. Furthermore, as shown above in regard to claim 3, the cited art does not disclose excluding one or more format features of the office document from the small device document. Thus, for at least the reasons provided above, the rejection of claims 16, 29, and 42, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10600/RCK.

Also enclosed herewith are the following items:

- ☐ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,

/Robert C. Kowert/

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